

# BEST AVAILABLE COPY

Serial No. 09/893,223

Docket No.: 117-P-1062USD1

## Remarks

The Response filed October 29, 2004 was deemed to be not fully responsive, on grounds that:

*"Applicant has not fully responded to the rejection of claims 38-40 and 45-47 under 35 USC 102(b) based upon a public use or sale of the invention as set forth in paragraph nos. 6-7 of the Office Action mailed on 10/05/04. Applicant appears to have responded to a 102(b) rejection as anticipated by the disclosure of American Olean Co. CANYON RED tile, however, there is no discussion of a public use or sale of the invention as requested by the Examiner" (see the Office Action at numbered Paragraph 1, Page 2).*

No public use or sale of the invention of claims 38-40 or 45-47 has taken place or been admitted, notwithstanding the October 5, 2004 Office Action's averment that:

*"An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: Per Applicant's own admission on page 49, lines 18-19 continuing to page 50, Applicant states the quarry tile tested (including the new, untreated, core, and restored tiles) is sold by the American Olean Co. under the trademark Canyon Red™. (see the October 5, 2004 Office Action at numbered Paragraph 7, Page 3, emphasis added).*

Applicants' specification does not say that the "restored" tiles are sold by American Olean Co. Applicants say beginning at page 49, line 11 that:

*"X-ray microanalysis tests were conducted to determine the elements present in quarry tile. A new, untreated quarry tile was tested, as well as quarry tile treated by an acid etch process and a quarry tile treated with the cleaning and restoration process of the present invention. The first three columns show the composition of the tile's surface, whereas the right-hand column shows the composition of the core of a new, untreated tile. The type of quarry tile tested is sold by the American Olean Co. under the trademark Canyon Red™...The elemental analysis results are shown in Table I." (page 49, lines 10 through page 50, line 1, emphasis added).*

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Thus as explained in the specification, elemental analysis was used to determine the surface composition of a new, untreated American Olean Canyon Red tile, an acid etched American Olean Canyon Red tile, and an American Olean Canyon Red tile which had been subjected to the disclosed cleaning and restoration process. As also explained in the specification, elemental analysis was used to determine the composition of the core of a new, untreated American Olean Canyon Red tile.

The disclosed cleaned and restored tiles are not "sold" by American Olean, and applicants did not say they were. Applicants' specification should be read in its entirety.

The October 5, 2004 Office Action also averred that:

*"Thus if the instant claims have a tile floor having an elemental composition substantially the same as that of the core of a new, untreated tile, then the elemental composition of the claimed tile floor is the same as what is commercially sold by American Olean Co. (the Canyon Red™ tile). The core of a new untreated tile would inherently be expected to function as the substantially the same elemental composition of the claimed tile floor and thus inherently exhibit the slip-resistant property.*

*Further, by Applicant's own admission, quarry tile naturally has microscopic (small) peaks and valleys at pg. 3, lines 5-6. Tiles are well known as flooring material having surfaces. coefficient of friction is an inherent property of the tile itself. Because the instant claim states the tile floor is "substantially the same" as a new untreated tile, then how is the tile floor different from what is already sold?" (see the October 5, 2004 Office Action at numbered paragraph 7, pages 3-4, emphasis added).*

As explained in applicants' October 29, 2004 response, this quoted argument appears to have overlooked the word "surface" in applicants' claim 45, which recites "A tile floor whose tiles have a floor surface that is slip-resistant, has small peaks and valleys, and has an elemental composition substantially the same as that of the core of a new, untreated tile" (emphasis added). As shown in applicants' Table I (reproduced below), a floor made from new American Olean Canyon Red tile would not have "a floor surface that ... has an elemental composition substantially the same as that of the core of a new, untreated tile":

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TABLE I  
ELEMENTAL ANALYSIS

Element	Untreated	Acid Etched	Restored	Core
	Tile	Tile	Tile	
Silicon	51	39	51	51
Aluminum	32	29	22	23
Sodium	6	--	2	2
Potassium	5	3	6	7
Manganese	4	3	3	2
Calcium	2	4	2	2
Iron	1	20	12	12
Titanium	--	2	1	1
	<u>101</u>	<u>100</u>	<u>99</u>	<u>100</u>

(The above percentages do not include oxygen).

Applicants accordingly request withdrawal of the rejection of claims 38-40 and 45-47 under 35 USC 102(b).

#### Conclusion

No public use has taken place or has been admitted. Applicants have made an earnest effort to address the rejections and to explain why they should be withdrawn. Passage of their application to the Issue Branch is requested.

Respectfully submitted on behalf of  
Ecolab Inc.,

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